

***Remarks***

Reconsideration of this Application is respectfully requested. Upon entry of the foregoing amendment, claims 1-38 are pending in the application, with claims 1 and 19 being the independent claims. Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

***Rejections under 35 U.S.C. § 103***

Claims 1-14, 16, 17, 19-32, 34, and 35 are rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent No. 5,289,372 to Guthrie *et al.* (hereinafter "Guthrie"). Applicants respectfully traverse this rejection.

Independent claims 1 and 19 recite a method and system of conducting a *wireless* inventory of items. The Examiner acknowledges that Guthrie teaches wired connections to link the tags and the collectors. Office Action, p. 3; Guthrie, col 5, lines 37-39 ("sensors 18 are connected to the control unit 16 by way of separate data cables 24"). The Examiner also notes that Guthrie states that using wireless transmissions is not suitable for Federal Government facilities or when secrecy considerations are required. *Id.* Guthrie also states that highly sensitive equipment can be operationally contaminated by stray signal transmissions if RF transmissions are used. Col. 3, lines 40-44. Nevertheless, the Examiner asserts, contrary to the very teachings of Guthrie, that it would be obvious to poll the tags taught by Guthrie wirelessly. *Id.* The law followed by the Federal Circuit is that a *prima facie* case of obviousness is established when the teachings from the prior art itself would

appear to have suggested the claimed subject matter to a person of ordinary skill in the art. Guthrie actually teaches *away* from the claimed invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Guthrie clearly teaches that RF transmissions are not appropriate in the context of this invention.

Further, the independent claims 1 and 19 recite a "remote access sensor module comprises a coverage pattern that defines a physical area containing a plurality of items with their associated tags." The collectors 19 taught by Guthrie do not provide a "coverage pattern," as that term is well understood in the wireless community, since the collectors 19 can only receive data from sensors that are physically connected thereto.

Still further, as noted above, the claimed invention relates to a method and system of conducting a wireless *inventory*. Guthrie does not teach a method and system for conducting an inventory, but rather a global equipment tracking system that provides for configuration management information regarding the physical status of computer-related equipment. Col. 1, lines 5-10. The computer-related equipment taught by Guthrie is permanently situated. Thus there is no need to conduct an inventory of this equipment. In fact, Guthrie's system cannot be used to conduct an inventory since the collectors are connected to sensors via a wire. Guthrie's collectors thus can only interrogate sensors that they are attached to. Conducting an inventory, which implies items being removed/added from the inventory, is thus illogical in a wired environment. In short, as discussed above, there is no motivation provided by Guthrie to use wireless communication in such an environment. The Examiner has merely used impermissible hindsight to reject the claimed invention.

Accordingly, it is respectfully requested that the rejection of claims 1 and 19 be withdrawn. Alternatively, it is respectfully requested that the Examiner provide a prior art reference to support his conclusion that it would be obvious to modify Guthrie in the manner suggested.

Claims 2-14, 16, 17, 19-32, 34 and 35 depend from amended claims 1 or 19 and include the features recited therein. For at least the reasons discussed above, Applicants believe that these claims are patentable over Guthrie. Furthermore, Applicants incorporate their reply to the first non-final Office Action herein. Accordingly, Applicants request that the rejection of these claims also be reconsidered and withdrawn.

In regard to claims 6, 7, 24, and 25, Applicants respectfully disagree with the Examiner statements in the final Office Action. Guthrie, clearly teaches that the host computer checks the equipment at least every 24 hours to prevent stale data from being stored in the database. Col. 13, lines 56-62. The claimed security features, i.e., turning on a surveillance camera or activating a silent alarm, can be used for example to catch a thief. Activating such security features 24 hours later would be ineffective. Furthermore, there is no suggestion within Guthrie to turn on a surveillance camera or activate a silent alarm. The Examiner has essentially taken Official Notice that these items are well known in the context of the claimed invention. This is inappropriate under MPEP 2144.03. The Examiner is specifically requested to provide documentary evidence to support this rejection.

With further regard to claims 16 and 34, it is well established that the Examiner bears the burden of establishing *prima facie* obviousness of the claimed invention. Accordingly all the claim features must be shown to be taught or suggested. More specifically, all the words in the claim must be considered. Applicants believe that with respect to claims 16

and 34, among others, the Examiner has failed to establish *prima facie* obviousness of the claimed invention. Thus, Applicants respectfully traverse the Examiner's blanket assertion that the interrogation steps as set forth in claims 16 and 34 would have been obvious and request that the rejection of these claims be reconsidered and withdrawn. It is noted that the Examiner did not respond to this argument, which was previously made, in the final Office Action

Claims 15, 18, 33, and 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Guthrie (cited above) in view of U.S. Patent No. 3,689,885 issued to Kaplan *et al.* (hereinafter "Kaplan"). Claims 15, 18, 33, and 36 depend, respectively, from amended claims 1 and 19 and include the features recited therein. For at least this reason, these claims are believed patentable over Guthrie in view of Kaplan. Therefore, Applicants respectfully request that the rejection of these claims be reconsidered and withdrawn.

The Examiner also rejects claims 37 and 38 under 35 U.S.C. § 103 as being unpatentable over Guthrie in view of U.S. Patent No. 5,856,788 to Walter *et al.* ("Walter *et al.*"). First, Walter *et al.* do not teach performing multiple reads of a plurality of RFID tags to avoid time slot contention since the tags disclosed by Walter *et al.* do not respond within a time slot. Second, Walter *et al.* also do not disclose a network tag reader that interrogates a tag identified by a plurality of bits, wherein the tag responds to the network tag reader with a first plurality of the plurality of (ID) bits during a first read and a second plurality of the plurality of (ID) bits during a second read. Rather, Walter *et al.* interrogates a plurality of tags each having a unique identification using one bit at a time, referred to by Walter *et al.* as "bitwise interrogating." There is no suggestion that a plurality of bits be used to interrogate the tags. Finally, there is no suggestion to combine Guthrie with Walter *et al.*

beyond the Examiner's assertions. Accordingly, applicants respectfully request that the rejection be withdrawn.

### ***Conclusion***

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert Sokohl  
Attorney for Applicants  
Registration No. 36,013

Date: 5/7/03

1100 New York Avenue, N.W.  
Suite 600  
Washington, D.C. 20005-3934  
(202) 371-2600

**Version with markings to show changes made**

37. (Amended) The method of claim 1, further including the step of performing multiple reads of the tags by the network tag reader to avoid time slot contention, wherein the tag identification number includes a plurality of bits, wherein [the] a tag responds to the network tag reader with [uses] a first plurality of the plurality of bits during a first read and a second plurality of the plurality of bits during a second read.
38. (Amended) The system of claim 19, wherein the network tag reader performs multiple reads of the tags to avoid time slot contention, wherein the tag identification number includes a plurality of bits, wherein [the] a tag responds to the network tag reader [uses] with a first plurality of the plurality of bits during a first read and a second plurality of the plurality of bits during a second read.